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OFFICE OF PETITIONS
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In re Application of
Richard K. Ryan et al.
Application No. 09/606,495
Filed: June 29, 2000
For: Method for Managing a Financial
Security

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: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(a)
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This is in response to the petition under 37 CFR 1.47(a), filed June 29, 2000.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a). The reply to this decision may include an oath or declaration executed by the non-signing inventors in compliance with 37 CFR 1.63.

The above-identified application was filed on June 29, 2000 with a declaration in compliance with 37 CFR 1.63 and 1.64 and naming Richard K. Ryan, Brandt Thomas Brock, Gregory J. Garvin, Stephane Goyer, Brenda Marie Harwood, Amy Jo Lee, Mary Elaine Nestor and Karen S. Plush as joint inventors. The declaration is executed by joint inventors, Garvin, Goyer, Harwood, Lee, Nestor and Plush, but not executed by joint inventors Ryan and Brock. In addition, petitioner has submitted the instant petition and fee, the last known address of both non-signing inventors and affidavits of facts in support of the petition.

The affidavit of Mr. Roger Viola states that, on June 26, 2000, he contacted joint inventor Richard Ryan regarding execution of the application papers and declaration related to the above-identified application and Mr. Ryan expressly stated that he would not sign the application papers. Mr. Viola further states that, in view of Mr. Ryan's refusal, he would not forward copies

of the patent application to inventor Ryan before filing the patent application. Secondly, the affidavit of joint inventor Amy Jo Lee states that it is her understanding that, on June 23, 2000, Rebecca Wempe, an employee of Security Benefit Group, Inc. (SBGI), forwarded an e-mail version of the patent application to joint inventor Brandt Brock, the additional six joint inventors, and to herself. Ms. Lee further states that, on June 27, 2000, she met with joint inventor Brock and asked him to sign the application papers and he stated that he would not sign the application papers. Lastly, the affidavit of Annette Cripps, an Administrative Assistant for (SBGI), states that she presented joint inventor Brock with the declaration and assignment forms relating to the application and Mr. Brock refused to sign either form.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks item (1) set forth above.

As to item (1), Rule 47 applicant has failed to demonstrate that joint inventor Ryan was presented with a copy of the complete application papers (specification, claims, drawings) prior to his statement of refusal. If in fact joint inventor Ryan was not presented with a copy of the complete application papers, then Mr. Ryan rightfully refused to execute the documents which he was requested to sign since he could not attest that he has "reviewed and understands the application papers." Did inventor Ryan receive the application papers? Petitioner should either demonstrate that a copy of the application papers was presented to Mr. Ryan but he did not respond to the request that he sign the oath or declaration or that Mr. Ryan refused to accept delivery of the application papers in order to show that Mr. Ryan has refused to join in the application. The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events and should include documentary evidence, such as certified mail return receipt, cover letter of instructions, copy of e-mail transmission, telegram, etc. See MPEP 409.03(d).

As to the statement by Amy Jo Lee that Rebecca Wempe, an employee of (SBGI), sent an e-mail version of the application to Mr. Brock, no documentary or tangible evidence has been presented showing that the application papers were received by e-mail transmission by Mr. Brock or that the e-mail version was actually sent to Mr. Brock. Also, no statement of facts has been presented by Rebecca Wempe, the person having firsthand knowledge of the e-mail transmission of the application papers to Mr. Brock. Therefore, as stated above, before a refusal can be alleged, it must be demonstrated that joint inventor Brock was presented with a copy of the application papers; otherwise, Mr. Brock could not attest that he has "reviewed and understands the application papers" which he was requested to

sign. As previously stated above, rule 47 applicant must demonstrate with documented evidence that inventor Brock refuses to join in the application after having been presented with the application papers. Proof of the pertinent events should be made in a statement by someone with firsthand knowledge of the events and should include documentary evidence, such as certified mail return receipt, cover letter of instructions, telegram, copies of the e-mail notice sent to Mr. Brock, etc.

In order to expedite consideration of the petition under 37 CFR 1.47(a), petitioner may wish to consider submitting the renewed petition by facsimile transmission to the telephone number indicated below and to the attention of Latrice Bond.

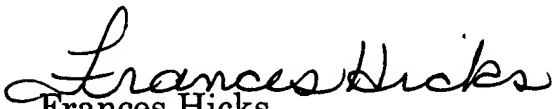
Further correspondence with respect to this matter should be addressed as follows:

By mail: Office of Petitions
Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries related to this decision should be directed to Latrice Bond at (703) 308-6911.


Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy